

Remarks/Arguments:

Claims 1 and 2 are pending in the above-identified application.

The Title of the invention has been objected to for not being descriptive. The Title of the invention has been amended accordingly.

Figure 6 has been objected to as lacking a prior art legend. Figure 6 has been amended accordingly.

Claims 1 and 2 were rejected under 35 U.S.C. § 102 (b) as being anticipated by Ichikawa et al. Claim 1 is amended to include,

...insert data reading means for receiving insert data ...

...data checking means for... comparing signal formats including data transfer rates between the insert data and the underlying data to determine whether the underlying data and the insert data have a common format;

warning indicating means for issuing a warning when said checking or said comparing indicates incompatibility between said underlying data and said insert data;

inserting means for inserting the data into the underlying data after said checking and said comparing indicates compatibility between said underlying data and said insert data;...

Basis for these amendments may be found in the specification at page 4, line 23 to page 5, line 8 and Figure 1. No new matter has been added. With regard to claim 1, Ichikawa et al. does not disclose or suggest comparing signal formats including data transfer rates between the data previously recorded on the recording medium (the underlying data) and the new data to be added to the recording medium (the insert data). Ichikawa compares a reference recording mode code with a reproduced recording mode code to identify whether a shift has occurred. (Paragraph [0009]). Thus, Ichikawa et al. does not compare signal formats and data transfer rates. Applicant's claimed feature of comparing signal formats including data transfer rates between the underlying data and the insert data is

advantageous over the prior art because comparing signal formats and data transfer rates looks for more than whether a shift has occurred. Comparing signal formats and data transfer rates looks for differences between signal formats and data transfer rates.

As further evidence, Applicants submit herewith a Declaration of Kei Ichikawa. Kei Ichikawa is one of the inventors of the Ichikawa reference (JP 07-161100) which has been asserted against claims 1 and 2. In this Declaration, Mr. Ichikawa asserts that in his opinion, one of ordinary skill in the art would not understand his patent as disclosing the above feature of comparing data transfer rates to determine whether signal formats of the two sets of data are identical. In view of Mr. Ichikawa's Declaration, the following Case Law is particularly on point:

[I]t is difficult to give credence to the Patent Office's position when the inventor of the invention cited as pertinent disagrees with its applicability.

Bowled Fluidics Base Corp. v. Mossinghoff, 620 F. Supp. 1927 (D.D.C. 1985). Accordingly, on the basis of Mr. Ichikawa's Declaration, the rejection of the claims 1 and 2 should be withdrawn.

Because Ichikawa et al. does not disclose or suggest the features of claim 1, claim 1 is not subject to rejection under 35 U.S.C. § 102(b) in view of Ichikawa et al. Claim 2 depends from claim 1. Accordingly, claim 2 is not subject to rejection under 35 U.S.C. § 102(b) in view of Ichikawa et al.

In view of the foregoing amendments and remarks, this Application is in condition for allowance which action is respectfully requested.

Application No.: 09/868,202
Amendment Dated: July 5, 2006
Reply to Office Action of: April 4, 2006

MAT-8151US

Respectfully submitted,


Lawrence E. Ashery, Reg. No. 34,515
Attorney for Applicant

LEA/fp/bj

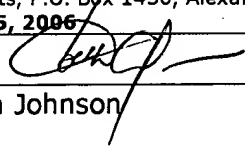
Attachment: Figure 6 (1 sheet)
Declaration Under 1.132

Dated: July 5, 2006

P.O. Box 980
Valley Forge, PA 19482-0980
(610) 407-0700

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. **18-0350** of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:
July 5, 2006


Beth Johnson

4461

Application No.: 09/868,202
Amendment Dated: July 5, 2006
Reply to Office Action of: April 4, 2006

MAT-8151US

Amendments to the Drawings:

The attached sheet of drawing includes changes to Figure 6. This sheet replaces the original sheet.